IN THE

Supreme Court of the United States

October Term, 1978

No. 78-185

AMERICAN INTERNATIONAL REINSURANCE COMPANY, INC.,

Petitioner,

v.

AIRCO, INC.,

Respondent.

REPLY MEMORANDUM FOR THE PETITIONER

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Respondent argues that this Petition for Certiorari is not timely, because it was not filed within ninety (90) days from February 23, 1978, the date of the lower Court's decision and opinion.

However, respondent recognizes that a Petition for Rehearing was timely filed with the Court of Customs and Patent Appeals (CCPA) and that, as a result, the mandate of that Court was not issued, much less entered, until May 4, 1978.* Nevertheless, respondent urges that the time for filing a Petition for Certiorari is not to be computed from the date of the issuance of the mandate, but from some earlier date.

* This Petition for Certiorari was docketed on August 2, 1978, within ninety (90) days of the issuance of the mandate.

Hence, the timeliness of this petition turns on whether the date of the lower Court's mandate may be regarded as the "judgment or decree" within the meaning of 28 U.S.C. 2101.

> ". . .We have taken and decided *as a matter of course* a considerable number of cases in which certiorari was sought within three months after entry of the 'order for mandate' but *not* within three months after the 'opinion' ". [Emphasis added] *Commissioner of Internal Revenue* v. *Bedford,* 325 U.S. 283, 285 (1945).

In making its argument, which is essentially a debate in semantics, respondent concedes that the rules of the CCPA, effective January 1, 1977, use neither the terms "judgment" or "decree"; the only terms used are "decisions", "opinions" and "mandates".

This Court has, in the past, been confronted with somewhat similar situations:

> "The Rules of the court below [Second Circuit Court of Appeals] governing opinions, rehearings, issuance of mandate and stay of mandate are invoked to show that the 'Opinion' is the appealable 'judgment'. These Rules, like other rules are not phrased with such fastidious precision as to make of all the parts a perfect harmony. But while substantial debating points may be taken, nothing in these Rules contradicts the natural meaning yielded by the terms of the 'Opinion' and the 'Order for Mandate' as reflected in the practice of the Second Circuit *and in our own, which treats not the 'Opinion' but the 'Order for Mandate' as the order of judgment.*" [Emphasis added] *Id.* at 287.

To support its argument that a "mandate" or "order" cannot be a "judgment" or "degree", respondent refers to

Black's Law Dictionary, Fourth Edition. However, according to that very reference, at page 977:

> "An order may be a judgment, [citing many cases]."

Then, in an effort to equate the term "decision" with "entry of judgment" respondent refers to the comments* of the Clerk of the CCPA, George E. Hutchinson, regarding a change of language in the rules of that Court, effective January 1, 1977. The change involved substituting "date of decision" for "entry of judgment" in setting the first day of the time period for filing a petition for rehearing and for issuing the mandate.**

Mr. Hutchinson concluded his remarks regarding this change by stating:

> "This was not a substantive change but only one of language to emphasize the fact that time periods for either a petition for rehearing or the issuance of a mandate are from the actual date of the decision or, to state another way, the issuance of the Court's opinion."

Indeed, there was no "substantive change" because a *certain day* is intended as the first day of the period within which a petition for rehearing is to be filed and a mandate is to be issued.

However, the Court recognized that it was clearly improper to call this day the date of "entry of judgment". Therefore, the language was changed to delete the improper phrase "entry of judgment" and to substitute the intended "date of decision" which, according to Mr. Hutchinson, is the date of the "issuance of the Court's opinion."

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* Footnote 1, page 3, of Respondent's Brief.

** Significantly, nothing is said regarding the period within which to file a Petition for Certiorari.

The CCPA is a very specialized court operating and interacting with the United States Patent and Trademark Office in a rather unique manner. Unlike other courts, the return of a case to the Commissioner of the Patent and Trademark Office is an integral and essential part of the process of judicial review.

According to the United States Code, a "certificate" of the court's "proceedings and decision" is to be entered of record in the Patent and Trademark Office.* Pursuant to Rule 6.2(a)** of the rules of the CCPA, a copy of the "opinion or order" is to accompany the mandate. Apparently, the mandate then is the "certificate" required by 35 U.S.C. 144.

Until such return is accomplished by the issuance of a mandate, the judicial proceedings have not been completed. We, therefore, submit that the mandate is the operative act of the CCPA which reflects and formalizes the Court's disposition of a case, and that it is this act which this Court will review on a petition for certiorari.

Respondent finally refers to a case, *Dann* v. *Chatfield*, (No. 76-1559), wherein this Court ruled that a petition for certiorari was untimely filed. The circumstances of the *Dann* case are somewhat confusing and, we submit, are not dispositive of the issue in this case.

In *Dann*, this Court had already rendered an exhausive decision on March 31, 1976, in which the Court reversed the CCPA and remanded the case. It appears from the brief of the petitioner in *Dann*, that, the CCPA thereafter served essentially an administrative function by issuing its own mandate in the furtherance of this Court's mandate.

* 35 U.S.C. 144, reproduced in the attached Appendix F.

** See Respondent's Brief, p. 7a.

When the petitioner in *Dann* then re-petitioned this Court for certiorari, such a re-petition was effectively a Rule 58 Petition for Rehearing which should have been filed within twenty-five (25) days of March 31, 1976, and which was, therefore, untimely.

In the instant case, the decision and opinion of the CCPA were rendered on February 23, 1978. A timely petition for rehearing was denied on April 27, 1978. Quite clearly, the time within which to file a petition for certiorari was stayed by this timely filing of a petition for rehearing.*

Then, pursuant to Rule 6.2(a) of the CCPA, the mandate properly issued on May 4, 1978 [seven (7) days after the Court's denial of petitioner's request for rehearing].

This petition for certiorari was filed precisely ninety (90) days after the issuance of the mandate complained of and, accordingly, we respectfully submit that this petition is timely.

Respectfully submitted,

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* *Nebraska* v. *Pink*, 317 U.S. 264 (1942).

APPENDIX F

35 U.S.C. §144 Decision on Appeal

The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent and Trademark Office, and the decision shall be confined to the points set forth in the reasons of appeal. Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent and Trademark Office and govern the further proceedings in the case.

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